

REMARKS

In the Office Action mailed September 9, 2004, the Examiner rejected claim 1 and withdrew claims 3, 6, 8, 9, 13 and 22-38. Applicants have not amended any claims of the application, however, Applicants offer a proposed amendment in section V of this Response below. Applicants have not indicated claims 3, 6, 8, 9, 13 and 22-38 as withdrawn since Applicants believe that such withdrawal was improper and feel that an indication of those claims being withdrawn may be construed as Applicants acquiescence in the improper withdrawal thereof.

Applicants traverse the withdrawal of claims 3, 6, 8, 9, 13 and 22-38 and the rejection of claim 1 on the following grounds: I) Inclusion of limitations that were not searched for a First Office Action is a legally improper reason for withdrawal of claims 22-24 and 27-38 in a Second Office Action; II) Withdrawal of claims 25-26 and 28-29 as being drawn to a non-elected species is improper where no species election excluding the language of those claims has ever been made; III) Withdrawal of claims 3, 6, 8, 9 and 13 as being drawn to a non-elected species in a Second Office Action is improper, particularly where those claims were treated as part of an elected species in the first Office Action; IV) The rejection of Claim 1 as being obvious is legally inadequate.

I. Inclusion of limitations that were not searched for a First Office Action is a legally improper reason for withdrawal of claims 22-24 and 27-38 in a Second Office Action.

The office action withdrew claims 22-24 and 27-38 suggesting that, "Newly submitted claims 22-24, 27-38 directed to an invention that is independent or distinct from the invention originally claimed [sic] for the following reasons: they include limitations which were not searched in before preparation of the first office action i.e. a roof panel; a side panel; etc." Applicants contend that this is an improper reason for withdrawal of claims 22-24 and 27-38.

The mere inclusion of limitations not searched prior to a first office action is an improper reason for withdrawal of claims from a patent application in a second or final office action. The MPEP explicitly contemplates that additional searching be done after the first or non-final Office Action and in preparation of a second or final Office Action if Applicants choose to amend a claim to include language not previously searched during preparation of the First Office Action. In support of this assertion, Applicants quote section 904 of the MPEP titled, "How to Search", which reads, "The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendment to the claims by the applicant in the first reply..."

As this section suggests, the MPEP contemplates that an Examiner, in preparation of a second or final office action, will need to do additional searching due to amendments presented in a Response to a first office action. As such, it is legally improper to refuse to do a second search merely because new claims, "include limitations which were not searched in before preparation of the first Office Action i.e. a roof panel; a side panel; etc." As such, the withdrawal of claims 22-24 and 27-38 on the grounds stated in the Office Action should be withdrawn.

In addition, Applicants suggest that any attempt to suggest that these claims can be withdrawn on the basis of a combination/subcombination restriction lacks legal merit. In particular, a combination/subcombination restriction requires that the Patent Office show that a subcombination is claimed separately from a combination and that the subcombination have utility separate from the combination. In the present instance; however, certain of the claims and particularly claims 22-24 only further define elements already in claim 1. There is no set of elements that would properly represent the claiming a subcombination separate from the original combination of claim 1 in these claims. Moreover, where language is added to the claims (e.g., language related to welds, paint or the like), such language is either within any election of the present application or is improperly excluded from such election as further discussed below. The withdrawal of claims 22-24 and 27-38 by the Office Action should be withdrawn.

II. Withdrawal of claims 25-26 and 28-29 as being drawn to a non-elected species is improper where no species election excluding the language of those claims has ever been made.

The Office Action suggests that, "claims 25-26 and 28-29 are withdrawn by the Examiner...as being drawn to a nonelected Species E. Species E does not contain the limitation of weld(s)."¹ However, Applicants have never made an election regarding welds. There is no mention of welds in the election/restriction requirement of March 31, 2004. Applicants are never requested to elect a species including or excluding welds. The application makes clear that the language discussing welds or the exclusion of welds can apply to each of the various embodiments of the invention shown in the drawings. As such, Applicants contend that the withdrawal of claims 25-26 and 28-29 is improper and should be withdrawn, particularly since Applicants were not afforded an opportunity to make an election regarding welds.

III. Withdrawal of claims 3, 6, 8, 9 and 13 as being drawn to a non-elected species in a Second Office Action is improper, particularly where those claims were treated as part of an elected species in the first Office Action.

The second or final Office Action of September 9, 2004 withdrew claims 3, 6, 8, 9 and 13 from further consideration, "and suggests that these claims are drawn to a nonelected Species E. Species E does not contain the limitation of a layer of primer and layer of paint."² However, the first Office Action of May 11, 2004 treated these claims as being part of the elected species and actually rejected claims 3, 6, 8, 9 and 13 under 35 U.S.C. 112 and under 35 U.S.C. 103. Applicants contend that it is improper to now suggest that those claims are not within the elected species. The withdrawal of claims 3, 6, 8, 9 and 13 should be withdrawn.

¹ Applicants assume that this quote is intended to suggest that the claims are drawn to a nonelected species rather than, as written, "a nonelected Species E", particularly since Applicants elected Species E.

Futhermore, Applicants contend that the final office action improperly denies entry of drawing amendments based upon the withdrawal of claims 3, 6, 8, 9 and 13. In particular, the final Office Action denies Applicant's request for amending Fig. 4 to include a primer layer 100 and a paint layer 102, but then suggests that an approval of such drawings, "could be granted but the claims [claims 3, 6, 8, 9 and 13] containing the limitation of a primer and a paint layer are withdrawn from further consideration..." Thus, based on the above, Applicants submit that this refusal to enter the amendments to Fig. 4 is based upon an improper withdrawal of claims 3, 6, 8, 9 and 13. Applicants request that such amendments to Fig. 4 now be approved.

IV. The rejection of Claim 1 as being obvious is legally inadequate.

The first office action rejected claims 1, 3, 8, 9 and 13 as being obvious. Applicants traversed those rejections and presented arguments suggesting that the rejections were legally inadequate. Applicants incorporate those arguments herein by reference.

The final Office Action suggests that, "Applicant has clearly indicated on pages 2, 3, 6, 7-11 of the specification that there is a commercially available material(s) which can be used having a tensile strength of a least 12Mpa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one of an automotive e-coat and automotive painting operation." Applicants contend that this argument has no bearing on the issue of obviousness. Even if such an indication were made by the specification³, commercial availability is not the test of obviousness. Moreover, such an indication would not relieve the Examiner's duty to present a prima facie case of obviousness by showing the elements of claim in the prior art and also showing motivation to combine those elements in the overall combinations set out in the claims of the application. Applicants contend that the rejection of claim 1 should be withdrawn.

² Applicants assume that this quote is intended to suggest that the claims are drawn to a nonelected species rather than, as written, "a nonelected Species E", particularly since Applicants elected Species E.

³ Applicants do not acquiesce in the indication suggested by the Office Action.

V. Interview of October 22, 2004

During an Interview between the undersigned and Examiner Patel on October 22, 2004, Examiner Patel suggested that he would consider allowing claims drawn more specifically directed toward an embodiment that Applicants, at least presently, view as more significant. In this vane, Applicants offer to cancel all claims 1-26, unless already canceled, and to amend claim 27 to include the language of both claim 30 and claim 31 and to cancel claims 32 and 33 if Examiner Patel allows claims 27-29 and 34-38.

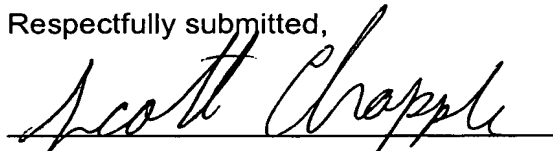
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections and withdrawals are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and request that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

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Respectfully submitted,



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